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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,201	07/11/2001	Eugene de Juan JR.	56247 (71699)	1217
21874	7590	02/22/2006	EXAMINER	
EDWARDS & ANGELL, LLP			DEMILLE, DANTON D	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			3764	
DATE MAILED: 02/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,201

Applicant(s)

JUAN ET AL.

Examiner

Danton DeMille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 22 is/are allowed.
- 6) ☒ Claim(s) 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 112

1. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 5-6, it is recited that the movable member is movable between a first position and a second position "external the moveable member". It is not clear how the movable member can move to a position outside of itself.

Claim Rejections - 35 USC § 103

2. **Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Sahatjian and optionally further in view of Krasner.**

3. Yamada already teaches mounting the deflated lens on the moveable member 28, moving the moveable member from a first position to a second position deploying the lens, forming the intraocular lens by injecting a medium into the lens and removing the moveable member from the lens and eye.

4. Regarding the language that the self-sealing mechanism is "configured to allow" subsequent access to the interior of the lens member, the self-sealing mechanism 16 of Yamada is "configured to allow" subsequent access to the interior if one were to do that. Since Yamada teaches that the gel filler 16 is self-sealing, an injection device is capable of being inserted into the intraocular lens to adjust the amount of optical medium and the gel filler 16 would seal around the injection device when inserted and seal when removed. Therefore it would appear Yamada teaches the last line limitation claimed.

5. The only difference between the claim and Yamada is the provision of an outer member that is intended to surround the moveable member 28 to protect the eye as well as the intraocular

lens and movable member while it is being inserted and removed from the eye. The language reciting the movable member movable between a first position and a second position appears to be merely describing the relative location of the moveable member within the outer member during insertion into the body and removal from the body.

6. Sahatjian teaches the conventional outer member 30 that contains and protects the inner inflatable moveable member during insertion into the body. It would have been obvious to one of ordinary skill in the art to modify Yamada to use a conventional separate outer sheath or tube around the inner inflatable moveable member as taught by Sahatjian to protect the human tissue and protect and guide the inflatable member to its destination.

7. Krasner teaches column 3, lines 15-19, the method of inserting an injection device in an already implanted lens for adjusting the amount of fluid within the lens after it has already been inserted in place. The self sealing gel 16 of Yamada would allow the function of re-inserting an injection device into the intraocular lens to adjust the amount of medium in the lens.

8. **Claims 1-20, 22 are allowable over prior art to which the examiner is aware.**

Response to Arguments

9. Applicant's arguments with respect to claims 23 and 24 have been considered but are moot in view of the new ground(s) of rejection.

10. With new claim 23 we are right back where we started. Trying to define the structure by describing functional intended use language is not going to define over the prior art. The structure of Yamada is capable of such intended use no matter what language is used.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danton DeMille whose telephone number is (571) 272-4974. The examiner can normally be reached on M-Th from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.


14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson, can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

18 February 2006


Danton DeMille
Primary Examiner
Art Unit 3764